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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
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| 09/921,635      | 08/03/2001  | James C. Sacchetti   | TAMK:247---12740.0247.NP | 5795             |

7590

04/30/2003

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EXAMINER

LY, CHEYNE D

ART UNIT

PAPER NUMBER.

1631

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/921,635

Applicant(s)

SACCHETTINI ET AL.

Examiner

Cheyne D Ly

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-45 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1631

### DETAILED ACTION

1. The art unit designated for this application has changed. Applicants(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

#### *Election/Restrictions*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a crystallized *M. tuberculosis* isocitrate lyase enzyme (ICL) and a computer readable media and a computer for producing a three-dimensional representation of the ICL, classified in class 702, subclass 27. If this Group is elected, then the below summarized species set (A), election of a species from this set is required.
- II. Claims 15 and 16, drawn to a method for evaluating the potential of a candidate compound associated with a molecule, classified in class 702, subclass 27. If this Group is elected, then the below summarized 2 species sets (A and B), election of a species from each set is required.
- III. Claims 17-34, drawn to a method for identifying an inhibitor of a microbial isocitrate lyase enzyme, classified in class 702, subclass 27. If this Group is elected, then the below summarized 3 species sets (A-C), election of a species from each set is required.
- IV. Claims 35 and 36, drawn to a method for identifying a potential agonist or antagonist of a molecule, classified in class 702, subclass 27. If this Group is elected, then the below summarized 2 species sets (A and B), election of a species from each set is required.

Art Unit: 1631

- V. Claim 37, drawn to a method for identifying an agent for use in treatment of chronic tuberculosis, classified in class 702, subclass 27. If this Group is elected, then the below summarized 2 species sets (A and B), election of a species from each set is required.
- VI. Claims 38-45, drawn to a method for identifying an agent for use in treating or preventing a persistent microbial infection, classified in class 702, subclass 27. If this Group is elected, then the below summarized 2 species sets (A and B), election of a species from each set is required.

#### **SPECIE ELECTION REQUIREMENT**

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

##### **FOR ALL GROUPS:**

##### Species of inhibitors (A):

4. Species of inhibitors, 3-bromopyruvate and 3-nitropropionate, listed in claim 1, which are generally separately analyzed and published, and thus document the undue search burden if searched together. Thus, applicants are required to select an unspecified type of inhibitor or a type of inhibitors from those listed in claim 1.

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3, and 6-45 are generic to the above species in all Groups.

##### **FOR GROUPS II-VI:**

Art Unit: 1631

Species of candidate compound (B):

6. Species of candidate compounds are cited in claims 21-23, which are generally separately analyzed and published, and thus document the undue search burden if searched together. Thus, applicants are required to select an unspecified type of candidate compound or a type of candidate compound from those listed in claim 21-23. It is noted that these candidate compounds types are utilized in groups III-VII although only cited specifically in Group III.

7. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 17-20 and 24-45 are generic to the above species in all Groups.

**FOR GROUP III:**

Species of inhibitors (C):

8. Species of inhibitors are cited in claims 30 and 31, which are generally separately analyzed and published, and thus document the undue search burden if searched together. Thus, applicants are required to select an unspecified type of inhibitor or a type of inhibitor from those listed in claim 30 and 31.

9. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 17-29 and 32-34 are generic to the above species in all Groups.

10. Applicant is advised that a reply to this requirement must include an identification of a specie from list of specie sets cited above that is elected consonant with this requirement, and a

Art Unit: 1631

listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

11. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

12. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

13. Inventions in Groups I and [II-VI] are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant application, the crystallized *M. tuberculosis* isocitrate lyase enzyme (ICL) and a computer-readable media of Group I may be utilized in the distinct usages as needed in Group II, which is a method for evaluating the potential of a candidate compound associated with a molecule. As needed in Group III, which is a method for identifying an inhibitor of a microbial isocitrate lyase enzyme. As needed in Group IV, which is

Art Unit: 1631

a method for identifying a potential agonist or antagonist of a molecule. As needed in Group V, which is a method for identifying an agent for use in treatment of chronic tuberculosis. As needed in Group VI, which is a method for identifying an agent for use in treating or preventing a persistent microbial infection. Alternatively, the crystallized *M. tuberculosis* isocitrate lyase enzyme (ICL) and a computer-readable media of Group I maybe used for determining the global fold of the said protein, for example. All of these usages are distinct as requiring distinct and different functions and results thereof without overlapping search due to different subject matter. This lack of overlapping searches documents the undue search burden if they were search together.

14. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

15. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

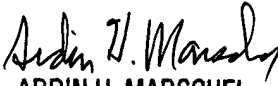
17. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (703) 308-3880. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

20. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly  
4/22/03

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER